

AMENDMENTS TO THE DRAWINGS

The attached sheet(s) of drawings includes changes to Figures 2, 3, and 4.

Attachment: Replacement sheets, Figures 2, 3, and 4.
 Annotated sheet showing changes, Figures 2, 3, and 4.

REMARKS

Claims 1-18 are pending in the application. Claims 1-18 have been rejected in the Office Action mailed November 24, 2004. Applicant respectfully traverses the rejections of claims 1-18 for the reasons set forth below.

Objections to the Specification

Applicant has amended the specification to recite the changes suggested by the Examiner. No new matter has been added.

Objections to the Drawings

The drawings are objected to as failing to comply with 37 C.F.R. § 1.84(p)(5) because they include reference characters not mentioned in the specification. Applicant has amended the specification to include the omitted references characters.

The drawings were also objected to because the axes in Figures 2, 3, and 4 were not labeled. Figures 2, 3, and 4 have been amended to correctly label the axes. In light of these amendments to the drawings and specification, Applicant respectfully requests that the Examiner withdraw the objections to the drawings.

Objections to the Claims

Claims 1 and 17 have been objected to for reciting the term “re-performing.” This term has been objected to as not being “a valid English word.” Applicant respectfully traverses the Examiner’s objection. “Re” is an English prefix and “performing” is an English base word, combined in this instance to form a separate English word comprising a prefix and a base word. Accordingly, Applicant respectfully asserts that “re-performing” is a valid English word. Additionally, Applicant reminds the Examiner that Applicant may be his own lexicographer, Lear Siegler, Inc. v. Aerogrip Corp., 221 U.S.P.Q. 1025, 1031 (Fed. Cir. 1984). Applicant respectfully requests that the Examiner withdraw the objection to claims 1 and 17.

The Examiner has advised in section 5 of the Office Action that if claim 14 is found allowable, claim 18 will be objected to under 37 C.F.R. § 1.75 as being a substantial

duplicate thereof. Applicant respectfully asserts that an objection to these claims under 37 C.F.R. § 1.75 is not proper. Claims 14 and 18 depend, respectively, from claims 13 and 17. Claims 13 and 17 have differing scopes. For example, claim 13 recites as the first method step “performing a full calibration scan” while claim 17 recites “performing a PRNU calibration scan.” Thus, dependent claims 14 and 18 also differ in scope and are not substantial duplicates of each other.

Claim Rejection under 35 U.S.C. § 103

Claims 1, 3, and 4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johnson et al.* (U.S. Patent No. 5,907,742, hereinafter *Johnson*) in view of *Hunter et al.* (U.S. Patent No. 5,369,423, hereinafter *Hunter*). To establish a prima facie case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

Claim 1 recites “re-performing the full calibration scan when the difference between the partial calibration scan and the full calibration scan is at least equal to a predetermined amount.” *Johnson* does not appear to teach or suggest at least this limitation of claim 1. *Hunter* recites a method and apparatus for automatic calibration. However, *Hunter* appears to teach comparing the results of scan data obtained during normal operation to desired intensity values obtained from a calibration operation that are stored in a look-up table. *See Hunter*, col. 6, line 51-col. 7, line 14. *Hunter* does not teach or suggest a partial calibration scan. Accordingly, neither *Hunter* nor *Johnson* teaches or suggests at least the limitations of claim 1 recited above. Therefore, claim 1 is not obvious over the cited references.

Claims 3 and 4 depend directly from base claim 1 and thus inherit all limitations of claim 1. Claim 1 sets forth features and limitations not taught or suggest by *Johnson* in view

of *Hunter*. Accordingly, Applicant respectfully asserts that for the above reasons claims 3 and 4 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim Rejection under 35 U.S.C. § 103(a)

Claims 7, 9, and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Hunter*, further in view of *Rombola* (U.S. Patent No. 6,518,587). To establish a prima facie case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

Claim 7 recites “adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount.” *Johnson* does not appear to teach or suggest at least this element of claim 7. *Hunter* recites a method and apparatus for automatic calibration. However, *Hunter* appears to teach comparing the results of scan data obtained during normal operation to desired intensity values obtained from a calibration operation that are stored in a look-up table. See *Hunter*, col. 6, line 51-col. 7, line 14. Thus, *Hunter* does not teach or suggest a partial calibration scan. *Rombola* recites a method of calibrating a scanner using an algorithm to determine if a defect exists in a light reference strip used for calibration. See *Rombola*, col. 2, lines 16-26. *Rombola* does not teach or suggest a partial calibration scan. Accordingly, *Rombola* does not teach or suggest at least the above-recited limitation of claim 7. Because the combination of *Johnson*, *Hunter*, and *Rombola* does not teach or suggest all limitations of claim 7, Applicant submits that claim 7 is not obvious over the cited references.

Claims 9 and 10 depend directly from base claim 7 and thus inherit all limitations of claim 7. Claim 7 sets forth features and limitations not taught or suggest by *Johnson* in view of *Hunter*, further in view of *Rombola*. Accordingly, Applicant respectfully asserts that for

the above reasons claims 9 and 10 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim Rejection under 35 U.S.C. § 103(a)

Claim 8 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Hunter*, further in view of *Rombola*, further in view of *Bromley* (U.S. Patent Application Publication No. US 2001/0030774 A1). To establish a prima facie case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

As shown above, neither *Johnson* nor *Hunter* nor *Rombola* teach or suggest at least “adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount,” as recited by claim 7. *Bromley* teaches a pre-scan for estimating the range of intensities expected in a subsequent full scan. See *Bromley*, paragraphs 0058, 0062. *Bromley* does not teach a partial calibration scan. Accordingly, *Bromley* does not teach or suggest at least the above-recited limitation of claim 7. Claim 8 depends directly from base claim 7 and thus inherits all limitations of claim 7. Claim 7 sets forth features and limitations not taught or suggest by *Johnson* in view of *Hunter*, further in view of *Rombola*, further in view of *Bromley*. Accordingly, Applicant respectfully asserts that for the above reasons claim 8 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim Rejection under 35 U.S.C. § 103(a)

Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Hunter*, further in view of *Rombola*, further in view of *North* (U.S. Patent No. 5,506,695). To establish a prima facie case of obviousness, three basic criteria must be

met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

As shown above, neither *Johnson* nor *Hunter* nor *Rombola* teach or suggest at least “adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount,” as recited by claim 7. *North* teaches periodic calibration of a photographic film scanning apparatus. See Col. 2, lines 51-53. *North* does not teach or suggest a partial calibration scan. Accordingly, *North* does not teach or suggest at least the above-recited limitation of claim 7. Claim 11 depends indirectly from base claim 7 and thus inherits all limitations of claim 7. Claim 7 sets forth features and limitations not taught or suggest by *Johnson* in view of *Hunter*, further in view of *Rombola*, further in view of *North*. Accordingly, Applicant respectfully asserts that for the above reasons claim 11 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim Rejection under 35 U.S.C. § 103(a)

Claim 12 has been rejected as being unpatentable over *Johnson* in view of *Hunter*, further in view of *Rombola*, further in view of *Brandkamp et al.* (U.S. Patent No. 5,153,745, hereinafter *Brandkamp*). To establish a prima facie case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

As shown above, neither *Johnson* nor *Hunter* nor *Rombola* teach or suggest at least “adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount,” as recited by claim 7. *Brandkamp* teaches a calibration system based on the standby time of a lamp. See *Brandkamp*, figure 5. *Brandkamp* does not teach or suggest a partial calibration scan. Accordingly, *Brandkamp* does not teach or suggest at least the above-recited limitation of claim 7. Claim 12 depends indirectly from base claim 7 and thus inherits all limitations of claim 7. Furthermore, *Brandkamp* does not teach or suggest the claim 12 limitation of “where the period between partial calibration scans is based on temperature.” *Brandkamp* teaches a calibration system based on the standby time of a lamp. See *Brandkamp*, figure 5. Accordingly, Applicant respectfully asserts that for the above reasons claim 12 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim Rejection under 35 U.S.C. § 103(a)

Claims 13, 14, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Bromley*, further in view of *Hunter*. To establish a prima facie case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

Claims 13 and 17 recite “performing at least one partial calibration scan without moving the scan head.” As shown above, neither *Johnson* nor *Bromley* nor *Hunter* teach or suggest performing a partial calibration scan. Accordingly, the cited references do not teach or suggest all limitations of claims 13 and 17. Applicant respectfully asserts that claims 13 and 17 are not obvious over *Johnson* in view of *Bromley*, further in view of *Hunter*.

Claim 14 depends directly from base claim 13 and thus inherit all limitations of claim 13. Claim 13 sets forth features and limitations not taught or suggest by *Johnson* in view of

Bromley, further in view of *Hunter*. Accordingly, Applicant respectfully asserts that for the above reasons claim 14 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim Rejection under 35 U.S.C. § 103(a)

Claims 15 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Hunter*, further in view of *Bromley*, further in view of *Rombola*. To establish a prima facie case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

Claim 15 recites “performing at least one partial calibration scan without moving the scan head.” As shown above, neither *Johnson* nor *Hunter* nor *Bromley* nor *Rombola* teach or suggest performing a partial calibration scan. Accordingly, the cited references do not teach or suggest all limitations of claim 15. Applicant respectfully asserts that claim 15 is not obvious over *Johnson* in view of *Hunter*, further in view of *Bromley*, further in view of *Rombola*.

Claim 16 depends directly from base claim 15 and thus inherit all limitations of claim 15. Claim 15 sets forth features and limitations not taught or suggest by *Johnson* in view of *Hunter*, further in view of *Bromley*, further in view of *Rombola*. Accordingly, Applicant respectfully asserts that for the above reasons claim 16 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Applicant respectfully requests that the Examiner withdraw all rejections of record and pass claims 1-18 to allowance. In view of the above, Applicant believes the pending application is in condition for allowance.

Application No.: 09/858,079

Docket No.: 10008017-1

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10008017-1, from which the undersigned is authorized to draw.

Dated: February 24, 2005

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482745477US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 24, 2005

Signature: _____

June Nguyen

Attachments: Drawing Sheets

Respectfully submitted,

By _____

Michael A. Papalas

Registration No.: 40,381

Attorney for Applicant

(214) 855-8186

A Calibration Method For Quick
Scanning Starts

ANNOTATED SHEET

Inventor: Nigel M-F Cheung



LIGHT
INTENSITY

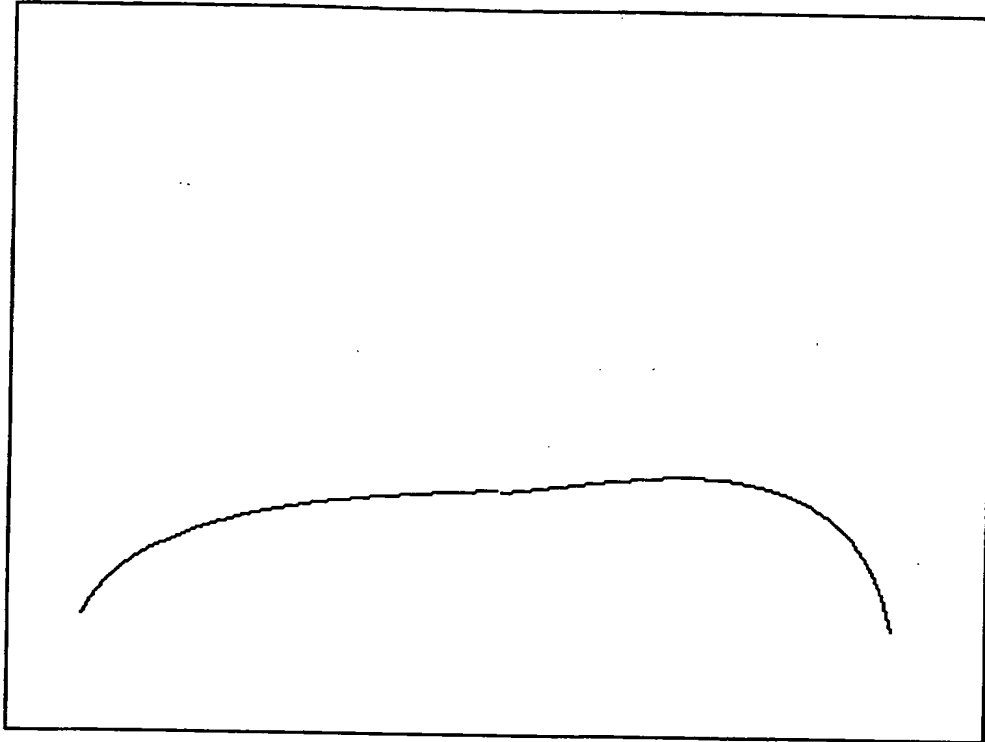


Figure 2

ANNOTATED SHEET Inventor: Nigel M-F Cheung

LIGHT
INTENSITY

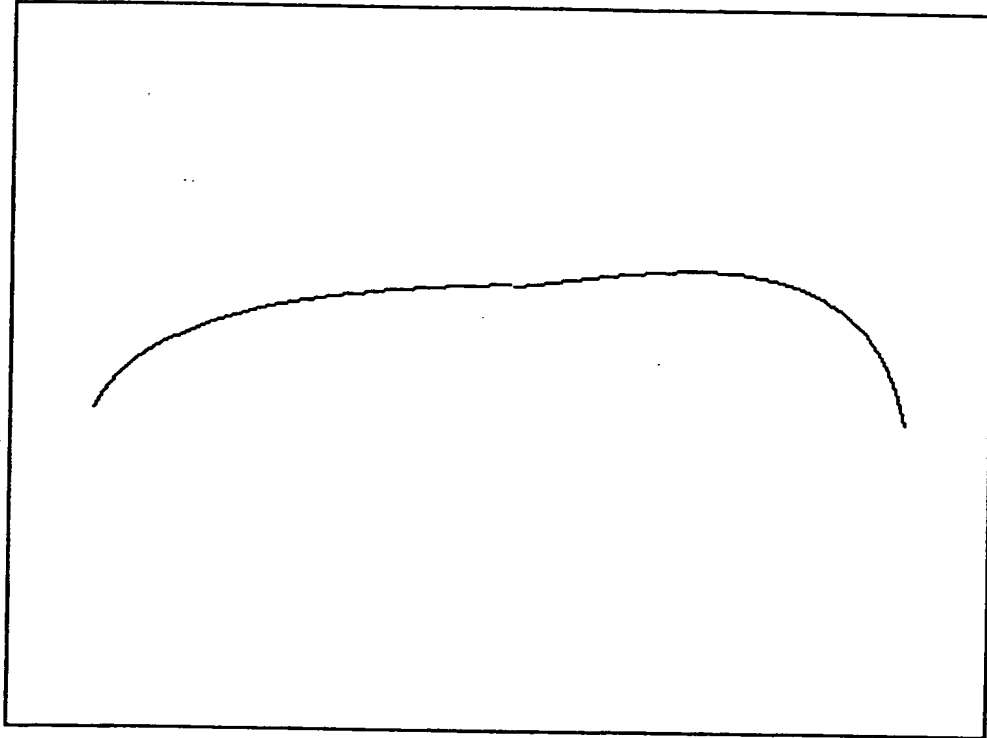


Figure 3

A Calibration Method For Quick
Scanning Starts

ANNOTATED SHEET Inventor: Nigel M-F Cheung

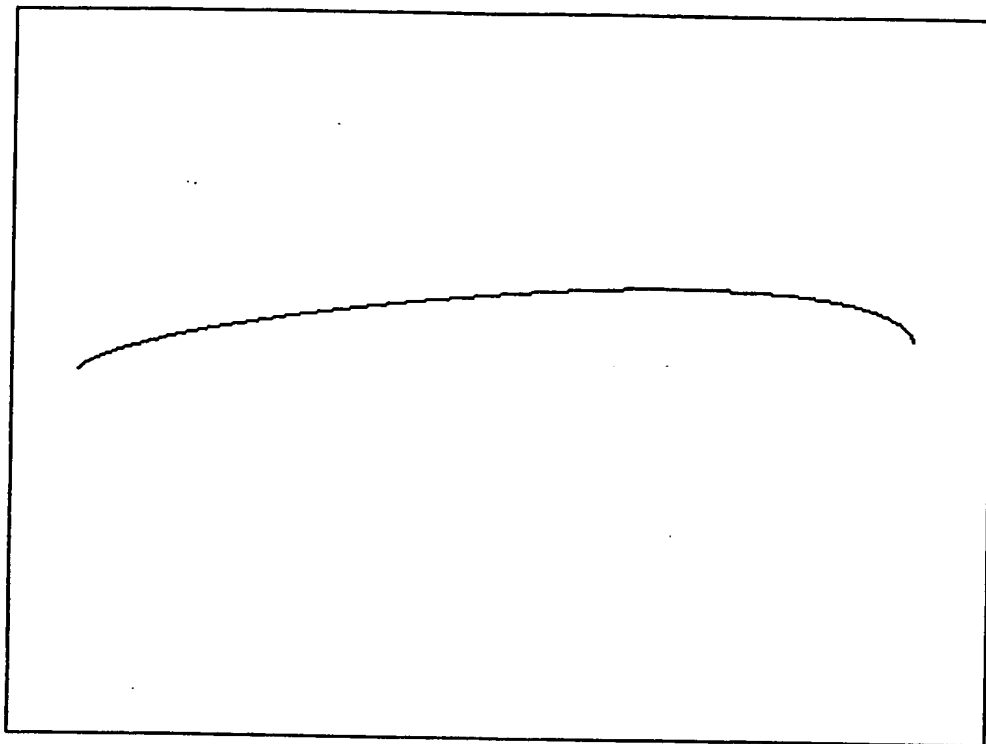
LIGHT
INTENSITY

Figure 4